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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,126	11/13/2003	Duane W. Marion	032,290-068	9937
34263	7590	09/07/2005	EXAMINER	
O'MELVENY & MEYERS LLP 610 NEWPORT CENTER DRIVE 17TH FLOOR NEWPORT BEACH, CA 92660			TOY, ALEX B	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/714,126

Applicant(s)

MARION ET AL.

Examiner

Alex B. Toy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 21-27, 44-58 and 60-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-12, 20 and 28-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03; 1/18/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 20, 28-43, and 59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 11/003267. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the initial movement of the electrode if one is controlling movement of the electrode in general. Further, it would have been obvious to use the electrosurgical assembly as specified in claims 28-43 and 59 to perform the method of controlling movement of the electrode in general as specified in claims 1-23 of copending Application No. 11/003267 because the assembly that controls initial movement is capable of controlling movement in general.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ein-Gal (U.S. Pat. No. 6,497,704 B2).

Regarding claim 12, Ein-Gal discloses a method for controlling the operation of a percutaneously-placed electrosurgical electrode of an electrosurgical device comprising:

delivering energy to a percutaneously-placed electrosurgical electrode 52 to create an arc thereat while moving said electrode (col. 9, ln. 8-10 and Figs. 1 and 2). It is noted that any electrosurgical electrode inherently creates an arc when energized during use;

monitoring an electrical characteristic associated with the electrosurgical electrode (col. 9, ln. 58 – col. 10, ln. 3 and Fig. 5); and

adjusting the energy delivered to the electrosurgical electrode based upon the monitoring step so to at least help maintain an effective arc (col. 10, ln. 4-9).

Regarding claim 20, Ein-Gal discloses a method for controlling the operation of a percutaneously-placed electrosurgical electrode of an electrosurgical device comprising:

delivering energy to a percutaneously-placed electrosurgical electrode 52 to create an arc thereat while moving said electrode along a predetermined path (col. 9, ln. 8-10 and Figs. 1 and 2). It is noted that any electrosurgical electrode inherently creates an arc when energized during use, and since manipulator 32 is in a fixed position, the manipulator moves electrode 52 along an inherently predetermined path (col. 8, ln. 30-36 and Figs. 1 and 8A);

monitoring an electrical characteristic associated with the electrosurgical electrode (col. 9, ln. 58 – col. 10, ln. 3 and Fig. 5);

monitoring an expected position of said electrode along said predetermined path (col. 8, ln. 1-6); and

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adjusting the energy delivered to the electrosurgical electrode based upon the electrical characteristic and expected position monitoring steps so to at least help maintain an effective arc (col. 10, ln. 4-9 and col. 8, ln. 1-6).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Pat. No. 5,417,687 to Nardella et al.  
U.S. Pat. No. 5,472,441 to Edwards et al.  
U.S. Pat. No. 5,507,743 to Edwards et al.  
U.S. Pat. No. 6,022,347 to Lindenmeier et al.  
U.S. Pat. No. 6,080,149 to Huang et al.  
U.S. Pat. No. 6,287,304 B1 to Eggers et al.  
U.S. Pat. No. 6,440,147 B1 to Lee et al.  
U.S. Pat. No. 6,471,659 B2 to Eggers et al.  
U.S. Pat. No. 6,770,070 B1 to Balbierz  
U.S. PGPub 2003/0073993 A1 to Ciarrocca  
U.S. PGPub 2003/0120270 A1 to Acker

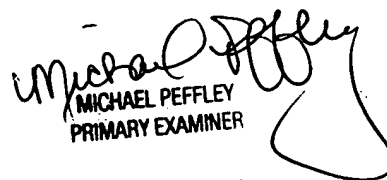
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AT AT  
9/1/05

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER